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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,649	02/29/2000	Kiyoshi Toyoda	P19157	2077

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EXAMINER

JONES, DAVID

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,649

Applicant(s)

TOYODA, KIYOSHI

Examiner

David L Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/514649, filed on 29 February 2000.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 6 June 2000 was filed after the mailing date of the application on 29 February 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

3. The disclosure is objected to because of the following informalities: Page 6, line 26, TIFF misspelled TIFRF.

Appropriate correction is required.

Claim Objections

4. Claims 1-16 is/are objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention or discovery.

The use of the word "center" in claims 1-16 is indefinite and is not distinct as claimed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 6, 9, 11, and 14, are rejected under 35 U.S.C. 102(e) as being anticipated by Miller, Jr. et al. U.S. Patent 6,356,356.

Regarding claim 1, Miller, Jr. et al. discloses an image communication apparatus comprising:

an image data transmitting and receiving section (fig. 1, #10) and an email transmitting section (fig. 1, #18) is adapted to transmit the image data transmitted and received by said image data transmitting and receiving section to a center (fig. 1, #12) on the Internet by use of e-mail (fig. 2, #36).

Regarding claim 3, Miller, Jr. et al. discloses an image communication apparatus comprising:

scanning section is adapted to scan an original to obtain image data (fig. 1, #10); and e-mail transmitting section (fig. 1, #18) is adapted to transmit e-mail including said image data to a transmission destination (fig. 1, #12) and a center (fig. 1, #26). The reference resembles the

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instant application FIG. 1, item #8 (Securities Firm A) and #9 (File Server), where the information management center and the destination are the same.

Regarding claim 6, Miller, Jr. et al. discloses an image communication apparatus comprising:

facsimile transmitting section (fig. 1, #10) is adapted to transmit information through a facsimile protocol (column 3, lines 12-28); and e-mail transmitting section (fig. 1, #18) is adapted to transmit e-mail (fig. 2, #38) including said image data to a center.

Regarding claim 9, Miller, Jr. et al. discloses an image communication method comprising:

transmitting and receiving image data (fig. 1, #10); and transmitting said image data transmitted and received to a center (fig. 1, #12) on the Internet by use of e-mail (fig. 2, #36).

Regarding claim 11, Miller, Jr. et al. discloses an image communication method comprising:

scanning an original to obtain image data (fig. 1, #10); and transmitting e-mail including said image data to a transmission destination (fig. 1, #12) and a center (fig. 1, #26).

Regarding claim 14, Miller, Jr. et al. discloses an image communication method comprising:

transmitting information through a facsimile protocol (column 3, lines 12-28); and transmitting e-mail including said image data to a center (fig. 1, #12).

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, Jr. et al.

Regarding claims 4 and 12, Miller, Jr. et al. teaches that said e-mail transmitting section sets a mail address of the transmission destination (fig. 1, #12) and a mail address of the center (fig. 1, #26) to said email, respectively, from the facsimile document. Further, it would have been obvious to one skilled in the art at the time the invention was made to send the document as an email to a destination and to send a copy to a log or server (column 5, lines 36-67, column 6, lines 1-8) that the system would have to include the ability to put the destination address in the [To:] field and the log address in the [BCC:] field.

Regarding claim 7 and 15, Miller, Jr. et al. teaches that said e-mail transmitting section sets the destination address of said e-mail (column 5, lines 36-67, column 6, lines 1-8), which maybe the server or recipient.

9. Claims 2, 5, 8, 10, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, Jr. et al. as applied to claims 1, 3, 4, 6, 7, 9, 11, 12, 14, and 15 above, and further in view of Palage et al. U.S. Patent 6,018,801.

Regarding claims 2, 5, 8, 10, 13, and 16, Miller, Jr. et al. teaches a system that includes

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the ability to send facsimile to both an email and normal fax system, but does not disclose what happens when an error is generated. Whereas, Palage et al. teaches that when an error email is generated it can be formatted to be sent to any number of addresses and any information maybe extracted as has been setup prior (column 7, lines 43-67). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to be able to send to a server and to a destination when an error-mail being generated, and that the ability to automatically print the same out is well known in the art from any facsimile device. Further, as taught by Palage et al. one could designate any information as needed and sent to any address.

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Conclusion


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weiser et al. U.S. Patent 5,982,507 and Freeman U.S. Patent 6,020,980 disclose a method and a system to translate a facsimile to email.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

David L. Jones


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